

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEUN-WOO PARK

Appeal No. 2002-0587
Application No. 08/922,300

HEARD: FEBRUARY 11, 2003

Before THOMAS, BARRY, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to the appellants' request for rehearing¹ of our decision mailed February 28, 2002 wherein we affirmed the examiner's rejection of claims 1-11 under 35 U.S.C. § 103(a).

We have carefully considered the arguments raised by appellant in his request for rehearing.

¹ Effective Dec. 1, 1997, 37 CFR § 1.197(b) was amended to change the term "reconsideration" to "rehearing." See the final rule notice published at 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)).

Appellant asserts (Req. Reh'g, page 5) that the Board erred with respect to the affirmation of the rejection of claim 1 due to an improper affirmation of the final rejection on new grounds not presented in the final rejection.

In response, appellant is correct that we did not affirm the rejection of claims 1-11 based on the portion of Martin relied upon by the examiner. Although we relied upon the same prior art applied by the examiner, as stated in our decision (pages 7 and 8), "we agree with appellant that a control grid is not the same as a deflection yoke of a CRT, and that the bias voltage applied to a control grid does not have the same function as the horizontal and vertical synchronization signals applied to the deflection yoke." Instead, we relied upon the horizontal deflection control circuit 36 of Martin. In analyzing the rejection of the claims under 35 U.S.C. § 103(a), part of our analysis includes determining the scope and content of the prior art. It was incumbent upon us to thoroughly review the prior art relied upon by the examiner. Appellant apparently appreciated the fact that the horizontal deflection control circuit 36 of Martin was more pertinent than the portion of Martin relied upon by the examiner, as it was appellant who brought this portion of Martin (horizontal deflection control circuit 36) to our

attention (reply brief, page 9). Because it was appellant that brought the pertinent portion of Martin to our attention, appellant should not be surprised that we relied upon the horizontal deflection control circuit 36 of Martin in our decision. Of note is that appellant has provided reasoning, in the reply brief, as to why appellant feels that the combined teachings of the admitted prior art and Martin would not result in the claimed invention.

Appellant further asserts that the inventor's identification of a problem in the prior art cannot be used as evidence of motivation to modify the prior art (Req. Reh'g., page 9). The examiner (answer, page 3) relied upon the Description of the Prior Art set forth on page 1, line 17 through page 4, line 5 of the specification in the rejection. We observe that page 1, line 17 through page 4, line 5 of the specification is entitled "Description of the Prior Art." In response, during prosecution before the examiner appellant never questioned any portion of page 1 line 17 through page 4, line 5 of the specification as not being prior art to appellant. In our decision, we relied upon the same portion of the specification as the examiner. Appellant's attempt to belatedly present new arguments directed to language in page 1, line 17 through page 4, line 5 as not properly being prior art to appellant is unavailing, since a

new argument advanced in a request for rehearing, but not advanced in appellants' brief (or reply brief), is not properly before the Board and will not be considered. See Ex parte Hindersinn, 177 USPQ 78, 80 (Bd. App. 1971) and Ex parte Harvey, 163 USPQ 572, 573 (Bd. App. 1968) (Question not presented to Board in appeal and not discussed by examiner is not appropriate for decision by Board on petition for reconsideration). Note also In re Kroekel, 803 F.2d 705, 708-09, 231 USPQ 640, 642-43 (Fed. Cir. 1986) and Cooper v. Goldfarb, 154 F.3d 1321, 1331, 47 USPQ2d 1896, 1904 (Fed. Cir. 1998) wherein the Court noted that a party cannot wait until after the Board has rendered an adverse decision and then present new arguments in a request for reconsideration.

Appellant further asserts (Req. Reh'g., page 11) that "[t]here has been no factual showing that 'causing a single line to be vertically drawn on the center of the screen' would damage the screen. . . Any holding that the screen in the AAPA would be damaged by the [line] vertically drawn on the center of the screen results from speculation, not fact." As stated in our decision (page 10) "In Martin, the horizontal deflection control circuit provides protection to the screen (col. 3, line 56) which is not the same as the user not being able to recognize the

information on the screen" (underlining added). Accordingly, the decision does not state that the inability to recognize the information on the screen means that the screen is damaged, although it recognizes that the single vertical line of information on the screen which occurs when the horizontal output circuit is damaged, is not recognizable to the user.

Appellant (Req. Reh'g., page 13) is correct that our statement on page 9 referring to Martin's teaching of slowly decaying the voltage to the horizontal deflection yoke was actually referring to the slowly decaying the voltage to transistor 58 of the horizontal deflection control circuit 36. However, we consider this to be harmless error, as it is clear from the passage what we were referring to.

It is additionally argued (Req. Reh'g., page 14) that although in AAPA, when power is interrupted, the high voltage charged on the horizontal deflection coil is not discharged, that there is no evidence that this phenomena causes damage to the screen.

Although AAPA does not disclose that the single vertical line formed on the screen causes damage to the screen, AAPA discloses (pages 3 and 4) that "a current surge resulting from the instantaneous high voltage abruptly flows through a discharge

loop damaging a portion of the horizontal output circuit. If the horizontal output circuit is damaged, no horizontal deflection is performed on the screen of the display device, thereby causing a single line to be vertically drawn on the center of the screen. As a result, the user cannot recognize the information displayed on the screen. Further, the peripheral devices and circuits may successively be damaged due to a short circuit resulting from the damage to the horizontal output circuit." We find that an artisan would have been motivated to prevent damage to the horizontal output circuit, unrecognizable information on the screen, and short circuiting of the peripheral devices and circuits.

It is further argued (Req. Reh'g., page 12) that "any modification of the AAPA would entail connecting protection circuit (36 which includes transistor 58) to the AAPA's transistor TR of horizontal output circuit 134 in the same manner as taught by Martin." We find that an artisan would have been motivated to connect the horizontal deflection control circuit 36 of Martin to the input of the H/V processor constant voltage circuit 131 because that is where the voltage supply is located, and because the current would flow to transistor TR, via circuits 131-133. In addition, because Martin discloses that the protection circuits are provided to regulate the input circuits to inhibit a high beam current which could otherwise damage the screen, an artisan would

be taught to provide the horizontal deflection control circuit 36 to the H/V processor constant voltage circuit 131. From all of the above, we are not persuaded of error on our part in affirming the rejection of claims 1-11 under 35 U.S.C. § 103(a).

However, inasmuch as the basic thrust of our affirmance of the 35 U.S.C. § 103 rejection of claims 1 through 11 in our original opinion differs from the portion of Martin and the rationale advanced by the examiner for the rejection, we hereby designate the affirmance therein as a new ground of rejection pursuant to 37 CFR § 1.196(b) to allow the appellants a fair opportunity to react thereto (see In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976)).

CONCLUSION

Accordingly, the decision of the examiner to reject claims 1-11 under 35 U.S.C. § 103(a) is affirmed, with the affirmance constituting new grounds of rejection under 37 CFR § 1.196(b).

37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection

to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
- (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

From all of the above, appellants' request for rehearing is granted with respect to reconsidering our decision as well as in designating our affirmance of the rejection of claims 1-11 as a New Ground of Rejection under 37 CFR § 1.196(b).

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REQUEST FOR REHEARING -GRANTED-IN-PART

JAMES D. THOMAS)
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STUART S. LEVY) AND
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